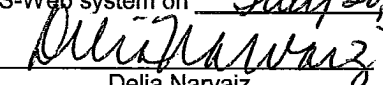


| IN THE UNITED STATES PATENT AND TRADEMARK OFFICE | |
|----------------------------------------------------------------------------------------------------------|---------------------------------------------|
| REQUEST FOR CORRECTED FILING RECEIPT | Atty. Docket No. LIBRE1100-6 |
| In re Application of: Tracey L. Jones | |
| Application Number: 09/690,368 | Filing or 371(c) Date: 10/16/2000 |
| For: METHOD, SYSTEM AND COMPUTER PROGRAM PRODUCT FOR DISPLAYING A VERSION OF A PAPER (AS AMENDED) | |
| Group Art Unit: 2178 | Confirmation No. 3107 |

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

| <u>Certificate of Transmission Under 37 C.F.R. § 1.8</u> |
|--------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| <p>I hereby certify that this correspondence is being deposited electronically with the U.S. Patent and Trademark Office using the United States Patent and Trademark Office's EFS-Web system on <u>July 20, 2011</u>.</p> <p style="text-align: center;"> Delia Narvaiz</p> |

Dear Sir:

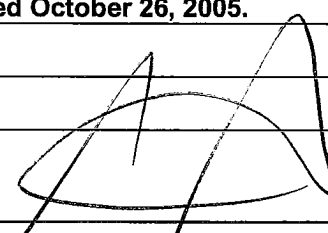
1. Attached is a copy of the official corrected filing receipt received from the PTO in the above application for which issuance of a corrected filing receipt is respectfully requested.
2. There is an error with respect to the following data, which is:

| | | |
|-------------------------------------|---------------------|--------|
| <input checked="" type="checkbox"/> | Incorrectly entered | and/or |
| <input type="checkbox"/> | Omitted | |

| | | <i>Error in</i> | | <i>Correct data</i> |
|----|-------------------------------------|----------------------|----|------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| A. | <input checked="" type="checkbox"/> | Priority Information | A. | Incorrect: 60/208,515 filed 06/01/2000; should be 60/208,015 filed 05/26/2000 ; see attached Supplemental Declaration submitted 06/11/2000 and Preliminary Amendment submitted June 7, 2001. |
| B. | <input type="checkbox"/> | Inventor's Info. | B. | |
| C. | <input checked="" type="checkbox"/> | Title | C. | METHOD, SYSTEM AND COMPUTER PROGRAM PRODUCT FOR DISPLAYING A VERSION OF A PAPER ; see attached Response to Office Action submitted October 26, 2005. |
| D. | <input type="checkbox"/> | Filing Date | D. | |
| E. | <input type="checkbox"/> | Other | E. | |

July 20, 2011

Date



Ari Akmal

Reg. No. 51,388



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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| APPL NO. | FILING OR 371 (c) DATE | ART UNIT | FIL FEE REC'D | ATTY. DOCKET NO | DRAWINGS | TOT CLMS | IND CLMS |
|------------|---------------------------|----------|---------------|-----------------|----------|----------|----------|
| 09/690,368 | 10/16/2000 | 2178 | 491 | 28150.11 | 27 | 24 | 3 |

27685
 HAYNES AND BOONE, LLP
 600 CONGRESS AVENUE
 SUITE 1600
 AUSTIN, TX 78701

CONFIRMATION NO. 3107
 CORRECTED FILING RECEIPT
 OC000000013972448
 OC000000013972448

Date Mailed: 10/01/2004

Receipt is acknowledged of this regular Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please write to the Office of Initial Patent Examination's Filing Receipt Corrections, facsimile number 703-746-9195. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).

Applicant(s)

Tracey L. Jones, Austin, TX;
 Billy P. Taylor, Cedar Park, TX;
 Frank H. Moeller, Austin, TX;

Power of Attorney: The patent practitioners associated with Customer Number **27685**.

Domestic Priority data as claimed by applicant

This appln claims benefit of 60/208,015 06/01/2000

Foreign Applications

60/208,015 05/26/2000

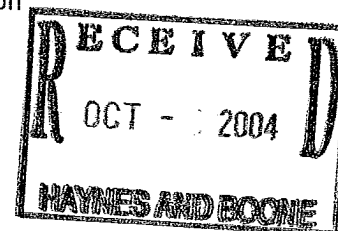
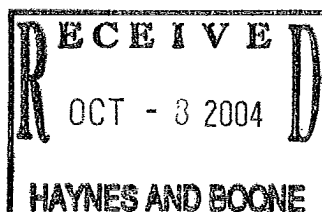
If Required, Foreign Filing License Granted: 12/05/2000

The number of your priority application, to be used for filing abroad under the Paris Convention is,
US09/690,368

Projected Publication Date: None, application is not eligible for pre-grant publication

Non-Publication Request: No

Early Publication Request: No



**** SMALL ENTITY ******Title**

Method and system for displaying a digital version of a mass-produced printed paper

Preliminary Class

715

**LICENSE FOR FOREIGN FILING UNDER
Title 35, United States Code, Section 184
Title 37, Code of Federal Regulations, 5.11 & 5.15**

GRANTED

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where the conditions for issuance of a license have been met, regardless of whether or not a license may be required as set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

This license is to be retained by the licensee and may be used at any time on or after the effective date thereof unless it is revoked. This license is automatically transferred to any related applications(s) filed under 37 CFR 1.53(d). This license is not retroactive.

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NOT GRANTED

No license under 35 U.S.C. 184 has been granted at this time, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is desired before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of this application and the licensee has not received any indication of a secrecy order under 35 U.S.C. 181, the licensee may foreign file the application pursuant to 37 CFR 5.15(b).

SUPPLEMENTAL DECLARATION

As below named inventors, we hereby declare that:

Our residence, post office address and citizenship are as stated below next to our names;

We believe we are the original, first and sole joint inventors of the subject matter which is claimed and for which a patent is sought on the invention entitled

**METHOD AND SYSTEM FOR DISPLAYING A DIGITAL
VERSION OF A MASS-PRODUCED PRINTED PAPER**

the specification of which: (check one)

_____ is attached hereto.

XXX was filed on October 16, 2000
under Attorney's Docket Number 28150.11
as Application Serial No. 09/690,368
and was amended on _____ (if applicable).

We hereby state that we have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment referred to above.

We acknowledge the duty to disclose information which is material to the patentability of this application in accordance with 37 CFR 1.56.

We hereby declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 USC 1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

We hereby claim the benefit under Title 35, United States Code, § 119(e) of any United States provisional application(s) listed below.

60/208,015
(Application Number)


May 26, 2000
(Filing Date)

POWER OF ATTORNEY: As a named inventor, we hereby appoint the following attorneys and/or agents to prosecute this application and transact all business in the Patent and Trademark Office connected therewith.

| | | | |
|-----------------------|-----------------|---------------------------|-----------------|
| Theodore Baroody | Reg. No. 45,417 | Michael J. Balconi-Lamica | Reg. No. 34,291 |
| Jeffrey M. Becker | Reg. No. 35,442 | Todd Mattingly | Reg. No. 40,298 |
| James R. Bell | Reg. No. 26,528 | David L. McCombs | Reg. No. 32,271 |
| L. Howard Chen | Reg. No. 46,615 | John W. Montgomery | Reg. No. 31,124 |
| Randall E. Colson | Reg. No. 40,566 | Bill R. Naifeh | Reg. No. 44,962 |
| Michael A. Davis, Jr. | Reg. No. 35,488 | David M. O'Dell | Reg. No. 42,044 |
| Ruben C. DeLeon | Reg. No. 37,812 | Phillip B. Philbin | Reg. No. 35,979 |
| Brian J. Hubbard | Reg. No. 45,873 | Constance M. Pielech | Reg. No. 46,991 |
| Rita M. Irani | Reg. No. 31,028 | Brandi W. Sarfatis | Reg. No. 37,713 |
| Warren B. Kice | Reg. No. 22,732 | | |
| Christopher P. Kosh | Reg. No. 42,760 | | |

Send correspondence to Christopher P. Kosh, Haynes and Boone, LLP,, 600 Congress Avenue, Suite 1600, Austin, Texas 78701 and direct all telephone calls to Christopher P. Kosh at 512/867-8400.

FULL NAME OF INVENTOR: Tracey L. Jones

INVENTOR'S SIGNATURE: 

DATED: 5-30-01

RESIDENCE: 12012 Portofino Drive, Austin, Texas 78732

CITIZENSHIP: United States of America

POST OFFICE ADDRESS: 12012 Portofino Drive, Austin, Texas 78732

PATENT / DOCKET NO.: 28150.11

FULL NAME OF INVENTOR: Billy P. Taylor

INVENTOR'S SIGNATURE: Billy P. Taylor DATED: 30 May 2001

RESIDENCE: 1302 Spotted Fawn Cove, Cedar Park, Texas 78613

CITIZENSHIP: United States of America

POST OFFICE ADDRESS: 1302 Spotted Fawn Cove, Cedar Park, Texas 78613

FULL NAME OF INVENTOR: Frank H. Moeller

INVENTOR'S SIGNATURE: F. Moeller DATED: 5/30/01

RESIDENCE: 4034 Ravine Ridge Trail, Austin, Texas 78746

CITIZENSHIP: United States of America

POST OFFICE ADDRESS: 4034 Ravine Ridge Trail, Austin, Texas 78746

a-114244.1

PATENT
Docket No.: 28150.11

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

| | | |
|------------------------------|---|----------------------|
| In re patent application of: | § | |
| Jones, T. et al. | § | |
| | § | |
| Serial No.: 09/690,368 | § | Group Art Unit: 2176 |
| | § | |
| Filed: October 16, 2000 | § | Examiner: Unknown |
| | § | |
| For: METHOD AND SYSTEM FOR | § | |
| DISPLAYING A DIGITAL VERSION | § | |
| OF A MASS-PRODUCED | § | |
| PRINTED PAPER | § | |

Box Non-Fee Amendment
Commissioner for Patents
Washington, D.C. 20231

PRELIMINARY AMENDMENT

Sir or Madame:

Please enter the following preliminary amendment.

IN THE SPECIFICATION

Please delete the paragraph on page 1, lines 5-9 and insert the following paragraph therefor:

-- This application claims priority to U.S. Provisional Patent Application No. 60/208,015, filed May 26, 2000, entitled **SYSTEM AND METHOD FOR PREPARING PRINTED MATTER FOR DELIVERY TO PERSONAL COMPUTERS** naming Billy P. Taylor as inventor. --

PATENT

Docket No.: 28150.11

Please delete the paragraph on page 1, lines 5-9 and insert the following paragraph therefor:

-- This application claims priority to U.S. Provisional Patent Application No. 60/208,015 [60/208,515], filed May 26, 2000, entitled SYSTEM AND METHOD FOR PREPARING PRINTED MATTER FOR DELIVERY TO PERSONAL COMPUTERS naming Billy P. Taylor as inventor. --

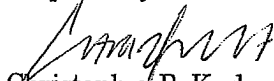
PATENT

Docket No.: 28150.11

Applicants respectfully requests entry of the above amendment.

The Commissioner is hereby authorized to charge payment of any fees associated with any of the papers submitted herewith to Deposit Account No. 08-1394.


Respectfully submitted,



Christopher P. Kosh

Registration No. 42,760

Dated: 6/4/01
HAYNES AND BOONE, L.L.P.
600 Congress Avenue, Suite 1600
Austin, Texas 78701
Telephone: [512] 867-8510
Facsimile: [512] 867-8470
a-114481.1

| |
|----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| Thereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner For Patents, Washington, D.C. 20231 on <u>6/5/01</u>  |
|----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|

**RECEIVED
CENTRAL FAX CENTER****OCT 27 2005****Fax Transmittal****DATE:** October 26, 2005**Total Pages (including this cover page):** 21

To: Commissioner for Patents
Examiner: Matthew J. Ludwig
Fax No.: 571-273-8300
Serial No.: 09/690,368

From: Michael A. Davis, Jr. **Davis Law Group, P.C.**
Direct Phone No.: (512) 306-8324 **9020 N. Capital of Texas Hwy.**
Direct Fax No.: (512) 306-8374 **Bldg. I, Suite 375**
E-mail: michael.davis@LegalVP.com **Austin, Texas 78759**
If you have any problem with this transmittal, please call: (512) 306-8324

Serial No.: 09/690,368**Filed:** October 16, 2000**Title:** METHOD, SYSTEM AND COMPUTER PROGRAM PRODUCT FOR DISPLAYING A
VERSION OF A HARDCOPY PAPER**Attorney Docket No.:** 1005.11**Dear Sir or Madam:****Attached please find the following regarding the above-referenced patent application:**

1. Transmittal letter, in duplicate; and
2. Response to Office Action.

Entry of these papers in the above referenced application is courteously solicited. Any question regarding this matter should be directed to the undersigned.



Michael A. Davis, Jr.
Registration No. 35,488

Confidentiality Note: The information contained in this facsimile message is privileged and confidential and is intended only for the use of the addressee. The term "privileged and confidential" includes, without limitation, attorney-client privileged communications, attorney work product, trade secrets, and any other proprietary information. Nothing in this facsimile is intended by the attorney or the client to constitute a waiver of the confidentiality of this message. If the reader of this message is not the intended recipient, or employee/agent of the intended recipient, you are hereby notified that any duplication, or distribution of this communication is unauthorized. If you have received this message in error, please notify us by telephone immediately so that we can arrange for the return of the original documents to us at no cost to you.

Serial No.: 09/690,368
Response to Office Action of 07/26/2005

Docket No. 1005.11
Customer No. 53953

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CENTRAL FAX CENTER

OCT 27 2005

In re application of:
Tracey L. Jones, et al.

Serial No.: 09/690,368

Group Art Unit: 2178

Filed: October 16, 2000

Examiner: Ludwig, M.

For: METHOD, SYSTEM AND
COMPUTER PROGRAM PRODUCT
FOR DISPLAYING A VERSION OF A
HARDCOPY PAPER

Confirmation No.: 3107

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Office Action mailed July 26, 2005, enclosed are the following regarding the above-identified patent application:

1. Transmittal letter (in duplicate); and
2. Response to Office Action.

☒ Small entity status of this application has previously been established.

☐ No additional fee is required.

The fee has been calculated as shown below:

| | (Col. 1) | | (Col. 2) | | (Col. 3) | SMALL ENTITY | | OTHER THAN A SMALL ENTITY | |
|-------------------------------------------|-------------------------------------------|-------|---------------------------------------|---|------------------|--------------|----------|------------------------------|-------------|
| | CLAIMS REMAINING AFTER AMENDMENT | | HIGHEST NO. PREVIOUSLY PAID FOR | | PRESENT EXTRA | RATE FEE | ADDIT. | OR | RATE FEE |
| TOTAL | 45 | minus | 24 | = | 21 | x 25 | \$ 525 | OR | x 50 |
| INDEP | 9 | minus | 3 | = | 6 | x 100 | \$ 600 | OR | x 200 |
| FIRST PRESENTATION OF MULTIPLE DEP. CLAIM | | | | | | + 180 | \$ | OR | + 360 |
| | | | | | | TOTAL | \$ 1,125 | OR | TOTAL |

☒ Please charge Deposit Account No. 50-3524 in the amount of \$ 1,125.

☐ A check in the amount of \$_____ is attached.

Serial No.: 09/690,368
Response to Office Action of 07/26/2005

Docket No. 1005.11
Customer No. 53953

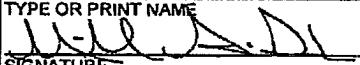
- [X] The Commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 50-3524.
- [X] Any additional filing fees under 37 C.F.R. § 1.16 for the presentation of extra claims.
- [X] Any patent application processing fees under 37 C.F.R. § 1.17.
- [X] A copy of this sheet is enclosed.

Respectfully submitted,



Michael A. Davis, Jr.
Registration No. 35,488

Date: October 26, 2005
Davis Law Group, P.C.
9020 N. Capital of Texas Hwy.
Bldg. 1, Suite 375
Austin, Texas 78759
Telephone 512-306-8324
Facsimile 512-306-8374
Docket Number: 1005.11

| | |
|-----------------------------------------------------------------------------------------------------------------------------|---------------------|
| I hereby certify that this paper is being facsimile transmitted to the Patent and Trademark Office on the date shown below: | |
| Fax Number: | <u>571-273-8300</u> |
| Michael A. Davis, Jr. | |
| TYPE OR PRINT NAME | |
|  | |
| SIGNATURE | |
| <u>October 26, 2005</u> | |
| DATE OF TRANSMISSION | |

Serial No.: 09/690,368
Response to Office Action of 07/26/2005

Docket No. 1005.11
Customer No. 53953

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

RECEIVED
CENTRAL FAX CENTER

OCT 27 2005

In re application of:
Tracey L. Jones, et al.

Serial No.: 09/690,368

Filed: October 16, 2000

For: METHOD, SYSTEM AND
COMPUTER PROGRAM PRODUCT
FOR DISPLAYING A VERSION OF A
HARDCOPY PAPER

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Group Art Unit: 2178

Examiner: Ludwig, M.

Confirmation No.: 3107

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO OFFICE ACTION

In response to the Office Action mailed July 26, 2005, please reconsider this application in view of the following remarks.

Amendments to the Specification begin on page 2 of this paper.

Listing of Claims section begins on page 3 of this paper.

Remarks section begins on page 13 of this paper.

10/28/2005 MBINAS 00000006 503524 , 09698368

01 FC:2202 525.00 DA
02 FC:2201 600.00 DA

Serial No.: 09/690,368
Response to Office Action of 07/26/2005

Docket No. 1005.11
Customer No. 53953

Amendments to the Specification

Please delete the title in its entirety and substitute the following replacement title in place thereof.

--METHOD, SYSTEM AND COMPUTER PROGRAM PRODUCT FOR
DISPLAYING A VERSION OF A ~~HARDCOPY~~-PAPER--

Serial No.: 09/690,368
Response to Office Action of 07/26/2005

Docket No. 1005.11
Customer No. 53953

Listing of Claims

The following listing of claims will replace all prior versions, and listings, of claims in the application.

1. (Currently amended) A method performed by a computer system, comprising:
storing an electronic version of a ~~hardcopy~~ paper, the electronic version being displayable on a display device as a likeness of the paper, wherein the paper is at least one of the following: a newspaper; ~~and a magazine; and a journal;~~

~~at a first location within the electronic version, in response to displayable content of the likeness, detecting a reference to at a first location within the displayable content of the likeness, the detected reference being associated with a second location, and wherein the detected reference is at least one of the following, other than a computer network address: an alphanumeric character; a symbol; a term; and a phrase; and~~

~~in response to the detected reference, embedding a hyperlink within the version between the first location, wherein the hyperlink is and the second location, and the first location being displayable on the display device as part of the likeness, highlighted to indicate the hyperlink, and selectable by a user to cause an operation associated with the second location.~~

2. (Previously presented) The method of Claim 1 and comprising:
on the display device, displaying a first selector associated with a first portion of the paper;
on the display device, displaying a second selector associated with a second portion of the paper; and
on the display device, displaying a likeness of the first portion in response to a selection of the first selector.

Serial No.: 09/690,368
Response to Office Action of 07/26/2005

Docket No. 1005.11
Customer No. 53953

3. (Currently amended) ~~A method performed by a computer system~~ ~~The method of Claim 1 and~~ comprising:

on a first date, receiving a watch list term that is specified by a user;
receiving an electronic version of a paper on a second date after the first date, and
searching the electronic version for the watch list term, without the user specifying the watch list
term after the first date, and without the user initiating the searching after the first date; and
outputting displaying a result of the searching for display on a display device.

4. (Currently amended) The method of Claim 3 and comprising:
in response to a selection of the result, displaying a likeness of a portion of the paper
~~associated with the selected result on the display device, wherein the watch list term is located in~~
the portion.

5. (Previously presented) The method of Claim 1 and comprising:
on the display device, in response to a user command, performing a pan function on the
likeness of the paper.

6. (Previously presented) The method of Claim 1 and comprising:
on the display device, in response to a user command, performing a zoom function on the
likeness of the paper.

7. (Currently amended) The method of Claim 1 and comprising:
in response to a selection of a portion of the electronic version, displaying the portion on
the display device as a likeness of the paper in an enlarged format.

8. (Currently amended) The method of Claim 1, wherein the first location is
highlighted ~~by an indicator to indicate the hyperlink, and comprising:~~
~~in response to a user command, selecting a type of the indicator.~~

Serial No.: 09/690,368
Response to Office Action of 07/26/2005

Docket No. 1005.11
Customer No. 53953

9. (Currently amended) A system, comprising:

a computing device for:

storing an electronic version of a ~~hardcopy~~-paper, the electronic version being displayable on a display device as a likeness of the paper, wherein the paper is at least one of the following: a newspaper; and a magazine; and a journal;

~~at a first location within the electronic version, in response to displayable content of the likeness, detecting a reference to at a first location within the displayable content of the likeness, the detected reference being associated with a second location, and wherein the detected reference is at least one of the following, other than a computer network address: an alphanumeric character; a symbol; a term; and a phrase; and~~

~~in response to the detected reference, embedding a hyperlink within the version between the first location, wherein the hyperlink is and the second location, and the first location being: displayable on the display device as part of the likeness; highlighted to indicate the hyperlink; and selectable by a user to cause an operation associated with the second location.~~

10. (Previously presented) The system of Claim 9 wherein the computing device is for:

on the display device, displaying a first selector associated with a first portion of the paper;

on the display device, displaying a second selector associated with a second portion of the paper; and

on the display device, displaying a likeness of the first portion in response to a selection of the first selector.

Serial No.: 09/690,368
Response to Office Action of 07/26/2005

Docket No. 1005.11
Customer No. 53953

11. (Currently amended) A system, comprising: The system of Claim 9 wherein the a computing device is for:
on a first date, receiving a watch list term that is specified by a user;
receiving an electronic version of a paper on a second date after the first date, and
searching the electronic version for the watch list term, without the user
specifying the watch list term after the first date, and without the user initiating
the searching after the first date; and
outputting displaying a result of the searching for display on a display device.
12. (Currently amended) The system of Claim 11 wherein the computing device is for:

in response to a selection of the result, displaying a likeness of a portion of the paper associated with the selected result on the display device, wherein the watch list term is located in the portion.
13. (Previously presented) The system of Claim 9 wherein the computing device is for:

on the display device, in response to a user command, performing a pan function on the likeness of the paper.
14. (Previously presented) The system of Claim 9 wherein the computing device is for:

on the display device, in response to a user command, performing a zoom function on the likeness of the paper.
15. (Currently amended) The system of Claim 9 wherein the computing device is for:

in response to a selection of a portion of the electronic version, displaying the portion on the display device as a likeness of the paper in an enlarged format.

Serial No.: 09/690,368
Response to Office Action of 07/26/2005

Docket No. 1005.11
Customer No. 53953

16. (Currently amended) The system of Claim 9, wherein the first location is highlighted by an indicator to indicate the hyperlink, and wherein the computing device is for: in response to a user command, selecting a type of the indicator.

17. (Currently amended) A computer program product, comprising:
a computer program processable by a computer system for causing the computer system to:

store an electronic version of a ~~hardcopy~~ paper, the electronic version being displayable on a display device as a likeness of the paper, wherein the paper is at least one of the following: a newspaper; ~~and a magazine; and a~~ journal;

at a first location within the electronic version, in response to displayable content of the likeness, detect a reference to at a first location within the displayable content of the likeness, the detected reference being associated with a second location, and wherein the detected reference is at least one of the following, other than a computer network address: an alphanumeric character; a symbol; a term; and a phrase; and

in response to the detected reference, embed ~~embedding~~ a hyperlink within the ~~version between the first location, wherein the hyperlink is and the second location, and the first location being: displayable on the display device as part of the likeness; highlighted to indicate the hyperlink; and~~ selectable by a user to cause an operation associated with the second location; and apparatus from which the computer program is accessible by the computer system.

18. (Previously presented) The computer program product of Claim 17 wherein the computer program is processable by the computer system for causing the computer system to:
on the display device, display a first selector associated with a first portion of the paper;
on the display device, display a second selector associated with a second portion of the paper; and
on the display device, display a likeness of the first portion in response to a selection of the first selector.

Serial No.: 09/690,368
Response to Office Action of 07/26/2005

Docket No. 1005.11
Customer No. 53953

19. (Currently amended) ~~A~~ ~~The computer program product of Claim 17 wherein the,~~
comprising:

a computer program is processable by a the computer system for causing the computer system to:

on a first date, receive a watch list term that is specified by a user;

receive an electronic version of a paper on a second date after the first date, and

search the electronic version for the watch list term, without the user

specifying the watch list term after the first date, and without the user

initiating the search after the first date; and

output display a result of the searching for display on a display device; and

apparatus from which the computer program is accessible by the computer system.

20. (Currently amended) The computer program product of Claim 19 wherein the computer program is processable by the computer system for causing the computer system to:

in response to a selection of the result, display a likeness of a portion of the paper associated with the selected result on the display device, wherein the watch list term is located in the portion.

21. (Previously presented) The computer program product of Claim 17 wherein the computer program is processable by the computer system for causing the computer system to:

on the display device, in response to a user command, perform a pan function on the likeness of the paper.

22. (Previously presented) The computer program product of Claim 17 wherein the computer program is processable by the computer system for causing the computer system to:

on the display device, in response to a user command, perform a zoom function on the likeness of the paper.

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23. (Currently amended) The computer program product of Claim 17 wherein the computer program is processable by the computer system for causing the computer system to:
in response to a selection of a portion of the electronic version, display the portion on the display device as a likeness of the paper in an enlarged format.

24. (Currently amended) The computer program product of Claim 17, wherein the first location is highlighted by an indicator to indicate the hyperlink, ~~and wherein the computer program is processable by the computer system for causing the computer system to:~~
~~in response to a user command, select a type of the indicator.~~

25. (New) The method of Claim 1, wherein the second location is located within the electronic version.

26. (New) The method of Claim 25, wherein the detected reference includes a page number of the second location.

27. (New) The method of Claim 1, wherein the operation includes displaying the second location on the display device.

28. (New) The method of Claim 1, wherein the electronic version is a second electronic version of the paper, and comprising:
translating a first electronic version of the paper into the second electronic version.

29. (New) The method of Claim 1, and comprising:
forming a link table in the electronic version; and
in the link table, storing information associated with the hyperlink.

30. (New) The method of Claim 8, wherein the first location is highlighted by an indicator to indicate the hyperlink, and comprising:
in response to a user command, selecting a type of the indicator.

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31. (New) The system of Claim 9, wherein the second location is located within the electronic version.

32. (New) The system of Claim 31, wherein the detected reference includes a page number of the second location.

33. (New) The system of Claim 9, wherein the operation includes displaying the second location on the display device.

34. (New) The system of Claim 9, wherein the electronic version is a second electronic version of the paper, and wherein the computing device is for translating a first electronic version of the paper into the second electronic version.

35. (New) The system of Claim 9, wherein the computing device is for:
forming a link table in the electronic version; and
in the link table, storing information associated with the hyperlink.

36. (New) The system of Claim 16, wherein the first location is highlighted by an indicator to indicate the hyperlink, and wherein the computing device is for:
in response to a user command, selecting a type of the indicator.

37. (New) The computer program product of Claim 17, wherein the second location is located within the electronic version.

38. (New) The computer program product of Claim 37, wherein the detected reference includes a page number of the second location.

39. (New) The computer program product of Claim 17, wherein the operation includes displaying the second location on the display device.

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40. (New) The computer program product of Claim 17, wherein the electronic version is a second electronic version of the paper, and wherein the computer program is processable by the computer system for causing the computer system to:

translate a first electronic version of the paper into the second electronic version.

41. (New) The computer program product of Claim 17, wherein the computer program is processable by the computer system for causing the computer system to:

form a link table in the electronic version; and

in the link table, store information associated with the hyperlink.

42. (New) The computer program product of Claim 24, wherein the first location is highlighted by an indicator to indicate the hyperlink, and wherein the computer program is processable by the computer system for causing the computer system to:

in response to a user command, select a type of the indicator.

43. (New) A method performed by a computer system, comprising:

storing an electronic version of a paper, the electronic version being displayable on a display device as a likeness of the paper, wherein the paper is at least one of the following: a newspaper; a magazine; and a journal;

at a first location within the electronic version, detecting a reference to a second location within the electronic version, wherein the detected reference includes a page number of the second location; and

in response to the detected reference, embedding a hyperlink within the first location, wherein the hyperlink is selectable by a user to cause displaying of the second location on the display device.

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44. (New) A system, comprising:
a computing device for:
storing an electronic version of a paper, the electronic version being displayable on a
display device as a likeness of the paper, wherein the paper is at least one of the
following: a newspaper; a magazine; and a journal;
at a first location within the electronic version, detecting a reference to a second location
within the electronic version, wherein the detected reference includes a page
number of the second location; and
in response to the detected reference, embedding a hyperlink within the first location,
wherein the hyperlink is selectable by a user to cause displaying of the second
location on the display device.

45. (New) A computer program product, comprising:
a computer program processable by a computer system for causing the computer system
to:
store an electronic version of a paper, the electronic version being displayable on
a display device as a likeness of the paper, wherein the paper is at least
one of the following: a newspaper; a magazine; and a journal;
at a first location within the electronic version, detect a reference to a second
location within the electronic version, wherein the detected reference
includes a page number of the second location; and
in response to the detected reference, embed a hyperlink within the first location,
wherein the hyperlink is selectable by a user to cause displaying of the
second location on the display device; and
apparatus from which the computer program is accessible by the computer system.

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REMARKS

Applicant respectfully requests reconsideration of this application in view of the following remarks. Claims 1, 3, 4, 7-9, 11, 12, 15-17, 19, 20, 23 and 24 have been amended. Claims 25-45 have been added. Claims 1-45 are pending. Antecedent basis for the amendments is located throughout Applicant's specification and the original claims (e.g., including, but not limited to, the discussion of Figs. 1, 2, 3z, 3aa, 3bb, 5, 6, 7, 8a and 8b). No new matter has been added.

Substitute Title

Applicant respectfully asks the Examiner to formally accept the substitute title.

35 U.S.C. § 112

The Office Action rejected claims 1, 9 and 17 under 35 U.S.C. § 112, second paragraph. Applicant has made an earnest attempt to amend the claims in a manner that overcomes such rejection. The amended claims no longer include the following phrases, which were cited in the Office Action: *"storing a version of a hardcopy paper"*; *"content of the likeness"*; *"the detected reference being associated with a second location"*; *"embedding a link within the version between the first location and the second location"*; and *"the first location being: displayable on the display device as part of the likeness."*

35 U.S.C. § 103(a)

In the Office Action mailed July 26, 2005, claims 1, 3, 9, 11, 17 and 19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0200507 ("Stern") in view of U.S. Patent No. 6,763,496 ("Hennings").

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Stern is *not* a prior art reference in this case

As explained in Applicant's previous Response to Office Action (filed by Applicant on July 5, 2005), Applicant's patent application claims priority to Applicant's U.S. Provisional Patent Application No. 60/208,015, filed *May 26, 2000* ("Applicant's May 26, 2000 Application"). By comparison, Stern's corresponding provisional patent application was subsequently filed *June 16, 2000*. Thus, Applicant's May 26, 2000 Application was filed *before* Stern, and *Stern is not a prior art reference in this case*.

Antecedent basis for claims 1, 3, 9, 11, 17 and 19 is located throughout Applicant's May 26, 2000 Application (e.g., including, but not limited to, the discussion at pages 10-15 of Applicant's May 26, 2000 Application). Applicant explained this fact in Applicant's previous Response to Office Action (filed by Applicant on July 5, 2005), but the Examiner did not comment on this fact.

Thus, if the Examiner continues to rely upon Stern in rejecting claims 1, 3, 9, 11, 17 and 19, then Applicant respectfully submits that the Examiner should *not* issue a "final" Office Action in this case, until after the Examiner: (a) explains how Stern qualifies as a prior art reference; and (b) permits Applicant to address such explanation in a subsequent Response to Office Action.

Hennings fails to teach claims 1, 3, 9, 11, 17, 19, 43, 44 and 45

Hennings fails to teach the combination of elements in claims 1, 3, 9, 11, 17, 19, 43, 44 and 45, and Hennings also fails to teach, or even suggest, any basis for combining in a 35 U.S.C. § 103 rejection. MPEP § 2143.01 states: "The mere fact that references can be combined or modified does *not* render the resultant combination obvious unless the prior art also suggests the desirability of the combination." As stated in MPEP § 2142, "...The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness..."

MPEP § 2142 states: "...the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made...The examiner must put aside knowledge of the applicant's

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disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole.'" Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated.

In relation to claims 1, 3, 9, 11, 17, 19, 43, 44 and 45, the motivation for advantageously combining the claimed elements would arise solely from hindsight based on Applicant's teachings in its own specification. Accordingly, the PTO's burden of factually supporting a prima facie case of obviousness has not been met.

Thus, in view of the reasons stated herein, and for other reasons clearly apparent, the PTO has not met its burden of factually supporting a prima facie conclusion of obviousness in this case, and Applicant has no obligation to submit evidence of nonobviousness.

Conclusion

For these reasons, and for other reasons clearly apparent, Applicant respectfully requests allowance of claims 1, 3, 9, 11, 17, 19, 43, 44 and 45.

Dependent claims 2, 5-8 and 25-30 depend from and further limit claim 1 and therefore are allowable.

Dependent claim 4 depends from and further limits claim 3 and therefore is allowable.

Dependent claims 10, 13-16 and 31-36 depend from and further limit claim 9 and therefore are allowable.

Dependent claim 12 depends from and further limits claim 11 and therefore is allowable.

Dependent claims 18, 21-24 and 37-42 depend from and further limit claim 17 and therefore are allowable.

Dependent claim 20 depends from and further limits claim 19 and therefore is allowable.

An early formal notice of allowance of claims 1-45 is requested.

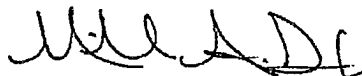
To the extent that this Response to Office Action results in additional fees, the Commissioner is authorized to charge deposit account no. 50-3524.

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Applicant has made an earnest attempt to place this case in condition for allowance. If any unresolved aspect remains, the Examiner is invited to call Applicant's attorney at the telephone number listed below.

Respectfully submitted,



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